

Notice of Allowability

Application No.

10/067,495

Examiner

Jennifer I. Harle

Applicant(s)

HORENSTEIN ET AL.

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 02/10/05.
2. ☒ The allowed claim(s) is/are 1-5,21-26,33-43,50-53,72 and 73.
3. ☒ The drawings filed on 04 February 2002 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

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DETAILED ACTION

1. Claims 1-5 and 21-54 were pending and subject to an Election/Restriction Requirement.
2. Claims 1-5, 21-22, 24-26 and 72 are pending. Claims 6-20, 23 and 27-74 are withdrawn as to a non-elected invention. Applicants' elected Group VII a chemical compound on February 10, 2005.
3. Claims 1-5, 21-26, 33-43, 50-53 and 72-73 are allowed. Applicants' were offered rejoinder of the method claims, on Friday, April 29, 2005, which was declined and canceled all remaining claims. Thus, claims 6-20, 23, 40, 43-49, 54-71 and 74 are canceled.

ELECTION/RESTRICTIONS

4. Applicant's election of Group VII, claim 1-5, 21-22, and 24-26 in the reply filed on December 7, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Applicants' Additional Amendment, filed February 10, 2005, reaffirming the election of Group VII is acknowledged and the addition of claim 71 by the examiner to the Group is noted. Again, because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
5. Applicant further elected the species, wherein $X=C$; $Y=N$; $Z=C$; $R_1=R_2=R_3=R_4=R_5=R_6=R_7=H$ and $R_8=CH_2OH$, which reads specifically on claims 1-2, 4-5, and 24-26 is noted.

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6. Claims 27-32 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 29, 2005.

7. The composition claims were rejoined in the same scope as the compound claims thus, claims 33-43, 50-53 and 73 were rejoined. Per the telephone conversation with Applicants' representative, composition claims 40, and 43-49 are canceled.

8. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims 54-71, directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, 54-71 now subject to being rejoined. However, claims 54-71, which were hereby rejoined and were not fully examined for patentability under 37 CFR 1.104 because Applicants' chose not to have them rejoined and chose to cancel claims 54-71 in a telephone conference call on April 29, 2005. Claims 54-71 and 74 are canceled.

Since all claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, the restriction requirement made in the Office action mailed on March 7, 2004 is hereby withdrawn.

EXAMINER'S AMENDMENT

9. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

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Authorization for this examiner's amendment was given in a telephone interview with Jenna M. Morrison on Friday, April 29, 2004.

The application has been amended as follows:

See attached 7 pages:

REASONS FOR ALLOWANCE

10. The following is an examiner's statement of reasons for allowance:

While very similar prior art compounds, including the elected species are known in the art, the quaternary ammonium salt of the elected species is not known (the elected species is known as an intermediate for making other products and there is no motivation to change the pH to create the quaternary ammonium salt). The other similar species fail to meet the specific limitations of either the combination of the R1 and R8 group and/or to be able to make a quaternary ammonium salt.

CONCLUSION

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I. Harle whose telephone number is (571) 272-2763. The examiner can normally be reached on Monday through Thursday, 6:30 am to 5:00 pm.,

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cecilia Tsang/
Supervisory Patent Examiner, Art Unit 1654

Jennifer I. Harle
Examiner
Art Unit 1654

May 2, 2005